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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,921	06/02/2001	Avram S. Grossman	907940-3	4642

7590   02/25/2005

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EXAMINER
AKLILU, KIRUBEL

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/872,921	GROSSMAN, AVRAM S.
	Examiner	Art Unit	
	Kirubel Aklilu	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 November 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Dureau

(U.S. Patent # 6,513,160).

1. As for **Claim 1**, Dureau teaches in a communications network having an interactive

delivery system (see Dureau col. 1 lines 9-12 "the invention relates to interactive

television systems and more particularly to means for inserting interactive content into

television programs through application executed in the set-top box of a television

system") and at least one network device (see fig. 1 unit 20 Set-Top Box, col. 4 lines 18-

43 "Receiving station 13 includes set-top box 20 and television 21. . .it is understood

this term refers to any processing unit for receiving and processing a transmitted signal

and conveying the processed signal to a television or other monitor"), a method for

operating the interactive delivery system comprising the steps of:

receiving a request for a commercial from the network device (see col. 2

lines 38-42 "The genie may be used in certain promotions, such as a lottery in

which the broadcast service provider provides selects and retrieves the genie of

a particular user so that the genie can be displayed in a broadcast" and col. 7

lines 28-35 "at the start of execution the interactive application checks for an

existing data file. If there is no data file, the application queries 52 the viewer as

to whether he or she wants to set up the genie character.". Since the genie may

be used in certain promotions, the genie is interpreted to function as a

commercial also. And since the user chooses to set up a genie character, the

action of the user choosing to set up a genie character, which can be used in

certain promotions, is interpreted to mean requesting for a commercial by the

user from the network device);

transmitting the requested commercial to the network device (see fig. 1

units 11, 12, and 13, col. 3 lines 47-58 "A remote station 11 is shown transmitting

a signal to broadcast station 12, which then transmits a signal to receiving station

13" and col. 4 lines 18-20 "Receiving station 13 includes set-top box 20");

transmitting interactive control information associated with the requested

commercial to the network device (see fig. 1 unit 18 App. Source, col. 4 lines 1-5

"Broadcast station 12 also includes application source 18, which provides the

interactive applications to processing unit 17. Processing unit 17 combines the

application and the television program for transmission to the receiving station

13."), whereby the network device uses the interactive control information to

present an interactive display to a user (see col. 4 lines 29-36 "The set-top box

executes the application and combines the audio and video portions of the

television program with video and/or audio generated by the application, as

required by the application. The modified television program signal is then

passed on to television 21");

and

receiving data describing the user's interaction with the interactive

display (see col. 6 lines 52-57 "The interactive application is configured to vary

the appearance and actions of the genie to reflect the "health" of the character,

which in turn is dependent upon the time the viewer spends watching the

associated program and/or the interactivity of the viewer with the program. This

viewing information is stored in a data file in the set-top box.").

2. As for **Claim 2**, Dureau teaches the commercial is a television commercial (see col.

3 lines 55-58 "The television program is typically a network television broadcast, but can

be any of a number of program types, such as taped shows, live broadcasts,

advertisements and the like").

3. As for **Claim 3**, Dureau teaches identifying the user (see col. 2 lines 39-44 "The

genie may be used in certain promotions, such as a lottery in which the broadcast

service provider selects and retrieves the genie of a particular user so that the genie

can be displayed in a broadcast. The user whose genie was so selected could then

contact the broadcast service provider to receive a prize."); and awarding at least one

point to the user based on the user's interactions (see col. 8 lines 21-24 "The application

may reward for such interaction by making the genie character appear more healthy, by

awarding points to the viewer's genie character").

4. As for **Claim 4**, Dureau teaches maintaining a user profile (see col. 2 line 67 – col. 3

line 2 "The application is received and executed by the set-top box, which also stores

data reflecting the viewer's viewing history."), the user profile including user

demographic information (see col. 1 lines 43-45 "These advertisements are designated

to attract and retain the attention of viewers, usually within a given demographic" and

col. 2 lines 56-59 "The method and apparatus are intended to increase the likelihood

that viewers in the targeted demographic groups will watch television programs and/or

advertisements and participate in associated promotions". It is inherent that a user

profile includes demographic information because the advertisements are targeted

according to demography) and personal preferences (see col. 3 lines 6-8 "Some of the

characteristics of the genie character, such as clothing and hair color, may be

customizable by the viewer").

5. As for **Claim 5**, Dureau teaches retrieving the user's personal profile (see col. Col. 3

lines 2-5 "Based upon the viewing history data, the application generates a cartoon

character such as a genie in the television display". The user viewing history is

interpreted to be a part of a user's personal profile); and

generating a list of available commercials matching the user's personal profile
(see col. 2 lines 56-59 "The method and apparatus are intended to increase the
likelihood that viewers in the targeted demographic groups will watch television
programs and/or advertisements and participate in associated promotions.". Since a
demography is specifically targeted, it is interpreted that the commercials that are
transmitted to a given demography are inherently a list of commercials that match the
profile of users in that demography); and

transmitting the generated list to the network device (col. 3 lines 47-58 "A remote
station 11 is shown transmitting a signal to broadcast station 12, which then transmits a
signal to receiving station 13" and col. 4 lines 18-20 "Receiving station 13 includes set-
top box 20").

Claims **6-7 and 9** are rejected under 35 U.S.C. 102(e) as being anticipated by
Balakrishnan et al. (U.S. patent # 6,473,903).

6. As for **Claim 6**, Balakrishnan et al. teach in a communications network having an
interactive delivery system (see fig. 3 unit 20 , col. 5 lines 23-37 "The system 20
includes a transmitter 22 which broadcast a multiplexed data stream . . ." and col. 1
lines 53-57 "the present invention encompasses a system for implementing an
interactive broadcast program, which includes a transmitter for transmitting a
multiplexed data stream which includes a main program and a plurality of different
commercials") and at least one network device (see fig. 3 unit 30 Receiver, col. 5 lines

30-33 "The system 20 further includes a receiver 30 which can be tuned to receive the

transmitted multiplexed data stream DS."), a method for operating the network device

comprising the steps of:

transmitting a request for a commercial to the interactive delivery system

(see col. 3 line 66 – col. 4 line 1 "The viewer can suitably use a remote

control unit (RCU) or other user control device to select the commercial

he/she desires to view");

receiving the requested commercial from the interactive delivery system

(see col. 4 lines 48-51 "the commercial packets comprising the commercial which

is selected for viewing can be re-assembled and displayed as a continuous

picture on the television screen");

receiving interactive control information associated with the requested

commercial (see col. 3 lines 45-51 "several different logos or video

sequences can be displayed on different portions or spatial locations of

the display area of the television screen. The logos or video sequences

are representative of the different products and/or services and/or

companies corresponding to the different commercials which are available

for display");

creating an interactive display using the interactive control information

(see col. 3 lines 40-55 ""several different logos or video sequences can be

displayed on different portions or spatial locations of the display area of

the television screen. The logos or video sequences are representative of

the different products and/or services and/or companies corresponding to

the different commercials which are available for display");

displaying the requested commercial (see col. 4 lines 48-51 "the

commercial packets comprising the commercial which is selected for

viewing can be re-assembled and displayed as a continuous picture on

the television screen");

processing user interactions (see col. 4 lines 6-9 "The application program

could be written to force the display of a default commercial in the event

the viewer does not select any commercial"); and

transmitting data describing the user interactions to the interactive delivery

system (see col. 6 lines 6-9 "If a reverse channel is available, the viewer

can choose to directly access material form the server or the WWW, e.g.

using a browser program that is resident either on the receiver or on a

peripheral device connected to the receiver").

7. As for **Claim 7**, Balakrishnan et al. teaches the commercial is a television

commercial (see col. 1 lines 53-59 the present invention, in one of its aspects,

encompasses a system for implementing an interactive broadcast program, which

includes a transmitter for transmitting a multiplexed data stream which includes a main

program and a plurality of different commercials, and a receiver (e.g., a digital television

receiver) configured to receive the multiplexed data stream." When the commercial is

received using a digital television receiver, it is interpreted the commercial is a television

commercial).

8. As for **Claim 9**, Balakrishnan et al. teaches receiving a list of available commercials

from the interactive delivery system (see col. 3 lines 43-45 "a choice (or menu) of

different commercials which are available to the viewer will be displayed"); and

displaying the list of available commercials for selection by the user (see col. 3 lines 43-

45 "a choice (or menu) of different commercials which are available to the viewer will be

displayed").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claim **8** is rejected under 35 U.S.C. 103(a) as being unpatentable over

Balakrishnan et al. (U.S. patent # 6,473,903) in view of Dureau (U.S. Patent #

6,513,160).

9. As for **Claim 8**, the claim differs in that Balakrishnan et al. do not expressly teach the

interactive control information includes at least one control function having an

associated point value.   However, Dureau teaches an interactive control information

that includes awarding points in response to a television user interacting with the

interactive control information (see col. 8 lines 21-24 "The application may reward for

such interaction by making the genie character appear more healthy, by awarding

points to the viewer's genie character"). In light of the teaching of Dureau, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to

modify the teaching of Balakrishnan et al. to have an associated point value when a

viewer selects a particular commercials from the list of available commercials displayed

in the interactive menu. One of ordinary skill in the art would have been motivated to

award points in response to a user selecting a commercial in order to give incentives for

viewers watching the transmitted commercials.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kirubel Aklilu whose telephone number is 703-305-8144

(571-282-7342 after 3/2/2005). The examiner can normally be reached on 9:00AM -

5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on 703-305-4795. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306 (571-

282-7353 after 3/2/2005).

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

KA
2/21/2005

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PRIMARY EXAMINER